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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,157	01/16/2002	Anthony L. Barrett	10012341-1	1881

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EXAMINER	
LETT, THOMAS J	
ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,157

Applicant(s)

BARRETT, ANTHONY L.

Examiner

Thomas J. Lett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/16/02</u> | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 1 and 11 provide for the use of an index mark added to a data entry, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass in order to add the index mark to each entry. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Support is not shown as to how the adding of an index mark is achieved. It is not disclosed how the user or client initiates the adding of an index mark (e.g., by use of a button, a GUI, mouse, voice command, etc.), and further, how an index mark is added to every Nth entry.

Claims 1 and 11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6, 8-12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Nishikawa (USPN 6,836,565 B1).

As best understood by Examiner, with respect to claim 1, applicant discloses on page 2, lines 2-4 of the specification, a method comprising: identifying a printer menu hierarchy, wherein the printer menu hierarchy includes multiple levels of data entries (page 2, lines 14-16).

Barrett does not disclose analyzing each level of data entries to determine the number of data entries associated with each level and that for each level of data entries having at least N data entries, adding an index mark to every Nth data entry in the level of data entries.

Nishikawa teaches of a directory window (see Figs. 13, and 17) having data listings in a tree structure that are numbered (usr1, ..., usr6) that can be selected. Once selected, by a mouse cursor or the like, the background color of the data listing is inverted (indicative of an index mark).

Barrett in view of Nishikawa are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would

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have been obvious to a person of ordinary skill in the art to add the inversion of background color to a listing of a hierarchical structure of Nishikawa to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag an entry.

With respect to claim 2, Barrett discloses, in admitted prior art a method comprising printing the printer menu hierarchy (page 2, lines 2-4). Barrett does not disclose including the added index marks in the printer hierarchy.

Nishikawa teaches of a directory window (see Figs. 13, and 17) having data listings in a tree structure that are numbered (usr1, ..., usr6) that can be selected. Once selected, by a mouse cursor or the like, the background color of the data listing is inverted (indicative of an index mark).

Barrett in view of Nishikawa are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the inversion of background color to a listing of a hierarchical structure of Nishikawa to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag an entry.

With respect to claim 3, Barrett does not disclose a method as recited in claim 1 wherein N is five.

Nishikawa teaches of a directory window (see Figs. 13, and 17) having data listings in a tree structure that are numbered (usr1, ..., usr6) that can be selected. Once selected, by a mouse cursor or the like, the background color of the data listing is

inverted (indicative of an index mark). It is obvious that any entry of Nishikawa in Figs. 13 and 17 may be selected.

Barrett in view of Nishikawa are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the inversion of background color to a listing of a hierarchical structure of Nishikawa to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag a particular entry.

With respect to claim 4, Barrett disclose a method as recited in claim 1 wherein the printer menu hierarchy is stored in a printer associated with the printer menu hierarchy (menu map for a particular printer can be printed, page 2, lines 16-18). Examiner notes that it is obvious that the menu map is stored on the particular printer.

With respect to claim 6, Barrett discloses a method as recited in claim 1 wherein the method is performed in response to a request to generate the printer menu hierarchy. Examiner notes that when printing the menu hierarchy, it would be obvious that a request was done by a user to generate the menu listing.

With respect to claim 8, Barrett discloses a method as recited in claim 1 wherein the data entries in the printer menu hierarchy include information related to printer settings (see page 2, lines 4-6).

With respect to claim 9, Barrett does not disclose a method wherein the index mark is a distinguishing characteristic applied to appropriate data entries.

Nishikawa teaches of a directory window (see Figs. 13, and 17) having data listings in a tree structure. Once a data listing is selected, by a mouse cursor or the like, the background color of a data listing is inverted (indicative of an index mark).

Barrett in view of Nishikawa are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the inversion of background color to a listing of a hierarchical structure of Nishikawa to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag an entry.

With respect to claim 10, Barrett discloses a method as recited in claim 1 wherein the index mark is a symbol added to appropriate data entries.

Nishikawa teaches of a directory window (see Figs. 13, and 17) having data listings in a tree structure that are numbered (usr1, ..., usr6) that can be selected. Once selected, by a mouse cursor or the like, the background color of the data listing is inverted (indicative of an index mark).

Barrett in view of Nishikawa are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the inversion of background color to a listing of a hierarchical structure of Nishikawa to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag an entry.

Claim 11 is rejected for the same reason as claim 1.

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Claim 12 is rejected for the same reason as claim 2.

Claim 14 is rejected for the same reason as claim 3.

Claim 15 is rejected for the same reason as claim 10.

4. Claims 5, 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrett's admitted prior art in view of Nishikawa (USPN 6,836,565 B1), and further in view of Webb et al (USPN 5,727,135).

With respect to claim 5, Barrett's admitted prior art does not disclose a method wherein the printer menu hierarchy is stored remotely from a printer associated with the printer menu hierarchy.

Webb et al teach of a printer menu that is remotely shown at a host computer a distance away from a plurality of printing devices and configuration settings of these remote printers can be controlled and saved from the host, see Fig. 1, and col. 10, lines 49-55).

Barrett and Webb et al are analogous art because they are from the similar problem solving area of saving printer menu data. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of Webb et al to Barrett in view of Nishikawa in order to obtain a method of remotely saving printer data. The motivation for doing so would be to save information at a more convenient location.

With respect to claim 7, Barrett does not disclose a method as recited in claim 1 further comprising:

retrieving the printer menu hierarchy from a printer using a computer coupled to the printer; and

displaying the retrieved printer menu hierarchy using the computer, wherein the displayed printer menu hierarchy includes the added index marks.

Webb et al teach of a printer menu that is remotely shown at a host computer a distance away from a plurality of printing devices and configuration settings of these remote printers can be controlled and saved from the host, see Fig. 1, and col. 10, lines 49-55). Webb et al also teach of an asterisk to signify that the value for the item is now a setting. Barrett in view of Nishikawa and Webb et al are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to the remote host computer feature to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag an entry.

Claim 13 is rejected for the same reason as claim 7.

5. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Streefkerk et al (USPN 6,058,277) in view of Barrett's admitted prior art and further in view of Nishikawa (USPN 6,836,565 B1).

With respect to claim 16, Streefkerk et al disclose a printer (printer combination 108, see Fig. 1) comprising:

a processor (controller 111, Fig. 1) configured to communicate with a storage device in the printer and to communicate with other devices coupled to the printer

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(controller 111 communicates with workstations 105, 106, printer 102, 103, col. 4, lines 19-27); and a storage device (workstation 105 which stores image information, col. 4, lines 10-15) coupled to the processor.

Streefkerk et al do not disclose a storage device containing a printer menu hierarchy associated with the printer, and wherein the printer menu hierarchy includes a plurality of data entries and an index mark associated with every Nth data entry in the plurality of data entries. Barrett discloses, in admitted prior art, a printer containing a printer menu hierarchy including multiple levels of data entries (page 2, lines 2-4).

Nishikawa teaches of a directory window (see Figs. 13, and 17) having data listings in a tree structure that are numbered (usr1, ..., usr6) that can be selected. Once selected, by a mouse cursor or the like, the background color of the data listing is inverted (indicative of an index mark).

Barrett in view of Nishikawa are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the inversion of background color to a listing of a hierarchical structure of Nishikawa to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag an entry.

With respect to claim 17, Streefkerk et al do not disclose a printer wherein the processor is further configured to print the printer menu hierarchy, including the index marks.

Barrett discloses, in admitted prior art, a printer containing a printer menu hierarchy including multiple levels of data entries (page 2, lines 2-4).

Nishikawa teaches of a directory window (see Figs. 13, and 17) having data listings in a tree structure that are numbered (usr1, ..., usr6) that can be selected. Once selected, by a mouse cursor or the like, the background color of the data listing is inverted (indicative of an index mark).

Barrett in view of Nishikawa are analogous art because they are from the similar problem solving area of enhancing a data listing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the inversion of background color to a listing of a hierarchical structure of Nishikawa to the disclosed prior art menu maps of Barrett in order to obtain an edited printer menu listing. The motivation for doing so would be to highlight or tag an entry.

With respect to claim 18, Streefkerk et al disclose a printer as recited in claim 16 wherein the storage device is a non-volatile memory device (workstation 105 which stores image information, col. 4, lines 10-15).

With respect to claim 19, Streefkerk et al disclose a printer as recited in claim 16 wherein the storage device is a hard disk drive (workstation 105 which stores image information, col. 4, lines 10-15).

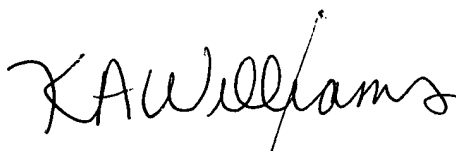
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571)272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL 


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER